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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,957	09/27/2000	Inching Chen	ITL.1780US (P9234)	8316
21906 7590 03/28/2012 TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER CZEKAJ, DAVID J	
			ART UNIT 2487	PAPER NUMBER
			MAIL DATE 03/28/2012	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INCHING CHEN

Appeal 2009-011974
Application 09/671,957
Technology Center 2600

Before MAHSHID D. SAADAT, MARC S. HOFF,
and KRISTEN L. DROESCH, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the non-final rejection of claims 4-9, 13, and 33-38. Claims 1-3, 10-12, 14-32, and 39-41 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse. We also enter a new ground of rejection in accordance with 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Introduction

Appellant's invention relates to a method and apparatus for manipulating and displaying MPEG video (*see* Spec. 3:30-34).

Exemplary independent claims 4 and 7 are reproduced below:

4. A computer implemented method comprising:
decoding a picture of an MPEG stream into a plurality of slices having a set of slices at least partially within an area of the picture, the area being less than all of the picture;
decoding at least the set of slices but not the plurality of slices into a plurality of macroblocks having a set of macroblocks within the area; and
decoding at least the set of macroblocks but not the plurality of macroblocks into pixels.

7. A computer implemented method comprising:
creating a first MPEG compliant substream from an MPEG stream including a plurality of pictures, the first substream corresponding to a first region of interest (ROI), said first ROI being an area of each picture of the plurality of pictures smaller than the total area of each picture;
transmitting the first substream to a first recipient;
creating a second MPEG compliant substream from the MPEG stream, the second substream corresponding to a second region of interest (ROI) that is different than the first ROI, said second ROI being an area of each picture of the plurality of pictures smaller than the total area of each picture; and

transmitting the second substream to a second recipient that is different than the first recipient.

Rejections

The Examiner rejected claims 4-6 and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over Koyanagi (US 5,557,332) and Wee (US 6,553,150 B1) and rejected claims 7-9, 13, and 36-38 under 35 U.S.C. § 103(a) as being unpatentable over Krishnamurthy (US 6,496,607 B1) and Li (US 6,807,550 B1).

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claims 4-6 and 33-35 because the relied-on portion in Column 24 of Wee does not teach or suggest “only decoding a set of slices” (App. Br. 9-10). Appellant points out that the examples depicted in Figures 15 and 17-19 of Wee, at best, disclose decoding all macroblocks within a slice instead of the “different decoding treatment of macroblocks within slices” (App. Br. 10).

2. With respect to the rejection of claims 7-9, 13, and 36-38, Appellant contends that the relied-on portion in Column 12 of Li does not teach or suggest the claimed “creating a second MPEG compliant substream from the MPEG stream, the second substream corresponding to a second region of interest (ROI); and transmitting the second substream to a second recipient that is different than the first recipient” (App. Br. 12). Appellant specifically asserts:

“Fairly read, this portion of Li et al. discloses a user changing a region of interest (ROI) in a browser, and rendering the new view based on content in a file. If the information necessary for the rendered view is not present in the file, it may be supplemented. This portion does not explicitly or “necessarily”

(i.e., inherently) teach or suggest *creating a new substream corresponding to a second ROI*, because such ROI information may be present in the Vfile, and thus not supplemented by any type of stream.

(*Id.*) (emphases added).

That Fig. 2 of Li et al. shows multiple clients is irrelevant, because col. 12, lines 30-51, of Li et al. refers explicitly to “a user,” “the browser,” and “the Vfile,” all singular.

(App. Br. 13).

ANALYSIS

With respect to the above first contention, we disagree with the Examiner that, in addition to decoding only select image slices, Wee decodes a set of macroblocks by only decoding “certain regions” (Ans. 6). The portion of Wee in Column 24, lines 39-53, which the Examiner relied on to support the above assertion, actually defines regions including different data types, such as “A,” “B,” and “C”. However, Wee further identifies 19 image slices in Figure 15, each having data belonging to one of those regions (*see* col. 24, ll. 54-61). Therefore, different decoded regions are determined based on the data type contained in each region, whereas “slices” contain data which correspond to different regions or parts of the image having a specific data type. In other words, as contended by Appellant (Reply Br. 1-2), Wee does not decode any macroblock as a part of a slice and instead, decodes the entire slice that corresponds to a region.

Regarding the above second contention, we also agree with Appellant that Li does not send a second substream to a second recipient. Contrary to the Examiner’s position (Ans. 7), the relied-on portion in Column 12 of Li merely discloses creating a second substream, which is sent

to the *same* client who received the first substream. While Figure 2 of Li shows multiple clients communicating with each other and a server (*see* col. 6, ll. 35-39), Li provides no discussion of transmitting a second substream corresponding to a different region of interest of a picture to a second clients. Neither has the Examiner explained how “sending streams to multiple different clients is a process that is well known in the art” (*see* Ans. 7) would have led the skilled artisan to create “a second MPEG compliant substream from the MPEG stream, the second substream corresponding to a second region of interest (ROI)” and to transmit “the second substream to a second recipient that is different than the first recipient,” as recited in claim 7.

CONCLUSIONS

On the record before us, we find that the Examiner erred in rejecting claims 4 and 7, as well as independent claims 13, 33, and 36, which include similar limitations. Therefore, we do not sustain the 35 U.S.C. § 103 rejections of claims 4, 7, 13, 33, and 36, nor of any claims dependent therefrom.

New Ground of Rejection -- 37 C.F.R. § 41.50(b)

We reject claims 33-38 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Independent claims 33 and 36 respectively recite “[a] machine-readable medium encoded with instructions, . . . :” and “[a] machine-readable medium that provides instructions,” Appellant states:

The techniques shown in the figures can be implemented using code and data stored and executed on computers. Such computers store and communicate (internally and with other computers over a network) code and data using machine-

readable media, such as magnetic disks; optical disks; random access memory; read only memory; flash memory devices; electrical, optical, acoustical or *other form of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.)*; etc. Of course, one or more parts of the invention may be implemented using any combination of software, firmware, and/or hardware.

(Spec. 14:12-19) (emphases added).

Thus, reading independent claims 33 and 36 in light of the Specification, the recited “machine-readable medium” encompasses a means that can propagate the program for use with an instruction execution system or a signal that contains the recited logic operations. Signals are not patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

Also, when read in light of the Specification, independent claims 33 and 36 include both statutory subject matter (instructions stored on a non-transitory medium) and non-statutory subject matter (instructions conveyed by a signal or transitory medium). According to USPTO guidelines, such claims must be amended to recite solely statutory subject matter. *See* David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *see also* U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf, Aug. 2009, at 2.¹

¹ We also direct attention to our reviewing court’s holding in *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1374 (Fed. Cir. 2011), stating that “[r]egardless of what statutory category (‘process, machine,

Dependent claims 34, 35, 37, and 38 similarly include logic on a machine-readable medium that can be a transitory medium or signal.

Based on the foregoing, we conclude that claims 33-38 are directed to non-statutory subject matter under 35 U.S.C. § 101.

DECISION

The Examiner's decision rejecting claims 4-9, 13, and 33-38 is reversed.

We have also entered new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 33-38.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection [. . .] shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

manufacture, or composition of matter,' 35 U.S.C. § 101) a claim's language is crafted to literally invoke, we look to the underlying invention for patent-eligibility purposes."

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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